

REMARKS

This Amendment is in response to the first Office Action mailed January 14, 2004. Claims 1-32 were examined in the Office Action and all were rejected.

Claims 3, 17, 20, and 22 have been amended above to correct for typographical errors. No claims have been added. No claims have been canceled. Claims 1-32 are currently pending. Reexamination and reconsideration are respectfully requested.

The specification has been amended. The deletion of the bracket on page 11, line 4 is to correct for a typing error. Further, on page 13, line 12 "300" has been replaced by "302" for consistency and agreement with the figures. Last, the serial number and patent number have been added for the incorporated reference.

Claim Rejections – 35 U.S.C. § 103

Claims 1-32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Leung (USPN 5,822,580). Applicant respectfully traverses Examiner's rejection. The PTO and Examiner carry the burden of "showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teaching of the references." *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Applicant respectfully believes Examiner has failed to carry that burden in showing "some objective teaching" in the prior art or that there is "knowledge generally available" to one skilled in the art. Examiner admits that the cited reference, Leung does not teach "delegating" as described and claimed in the application and instead relies on the vagaries of combining a reference with the elements Examiner believes to be obvious to one skilled in the art at the time of the invention. Further, the Examiner is not allowed to use hindsight when reaching the obviousness determination. *In re Fine*, 837 F.2d at 1075.

Claims 1, 17, 29 and all depending claims

A prima facie case of obviousness can only be established when all of the following requirements are met: (1) there must be some suggestion or motivation in the references themselves to combine the references; (2) there must be a reasonable expectation of success; and (3) the reference or combination of references must teach or suggest all the claim limitations. See MPEP §§ 706.02(j) and 2143.

The combination of references cited by the Examiner must teach or suggest every limitation of the claimed invention. *CFMT v. CFM Tech.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003). See also *In re Royka*; MPEP § 2143.03. When the Examiner relies upon "knowledge in the art," the Examiner is given an opportunity to "provide evidence in the next Office Action or explain why no evidence is required." MPEP § 2144.03. Examiner admits that Leung does not teach delegating the call to a responding table-oriented method of a lower-level table to which the first level table object is bound, if the first level table object depends on the lower-level table object to completely service the call. The Examiner did not cite any reference and is required to provide a reference or give reasons why no evidence is required.

Assuming arguendo that such a reference exists, Leung in combination with the alleged obviousness to one skilled in the art at the time of the invention, fails to establish a prima facie case in at least two additional respects. First, there is no motivation or suggestion to combine from the references themselves. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See *In re Gordon*, 733 F.2d 900; MPEP § 2143.01. Indeed, delegating to the lower level as defined in the present application would defeat the purpose of Leung. Leung is concerned with duplicative work and solves this by creating a single global registry. "Instead of each subsystem providing its own version of the registry (which would result in duplicate work), it would be 0more efficient to have a global class registry that is general and flexible enough to accommodate the configuration needs of all subsystems of the CommonPoint environment." (col 7, lines 42-47). See also (col 5, lines 55-60) and (col 3, lines 54-64) (further pointing out the need for one registry to prevent duplicative work).

Further, Leung teaches away from such a combination since it describes a single global registry that is necessary for the elimination of duplication. Consequently, delegating introduces an element contrary to the goals of Leung, because delegating would inherently introduce duplication. Leung teaches away in that delegation is undesirable. Leung in fact attempts to solve the problem of duplication by creating a single registry negating the need for delegation. Since, Leung teaches away and adding delegation would render Leung unsatisfactory, there is no motivation or suggestion to combine.

Second, there is no reasonable likelihood of success in combining the references or knowledge in the art. Combining Leung with a delegating feature result in an invention with a single global registry, which would delegate to the same registry, hence looking again for information in the same registry. The delegation step in such a combination adds additional work that is unnecessary and frustrates the goals of Leung.

Claims 1, 17 and 29, the independent claims of the application, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leung. Each independent claim contains an element related to delegating, which Examiner admits is not taught in Leung and has not provided a reference for showing delegation. In addition, there is no motivation to combine or a likelihood of success in combining with the alleged obviousness to one skilled in the art. Therefore, Applicant believes claims 1, 17 and 29 and all depending claims, claims 2-16, 18-28 and 30-32 are allowable. Applicant respectfully requests withdrawal of the rejection.

9,10 and 22

Leung does not teach synthesizing data associated with the first coordinate in a logic level table. Indeed, Examiner fails to cite where in the reference that Leung teaches synthesizing. Leung has no need of synthesizing since all data is contained within a single global registry. The motivation or suggestion to combine Leung with what is obvious to one skilled in the art to create a system with synthesis, as claimed, simply does not exist. Accordingly, Applicant respectfully requests withdrawal of the rejection of the dependent claims 9, 10 and 22 because there is no motivation or suggestion to combine Leung and synthesizing as well as the above discussion related to the independent claims.

Claim 7

A look up method from a query based on a set of attributes in Leung is not filtering configuration information depending upon the security level of the caller. The look up method of Leung searches through a list of object descriptors by generating a query based on a set of attributes. Leung neither suggests nor offers any motivation for filtering based on security. Indeed, filtering is contrary to the functionality of Leung because Leung seeks to increase access in an efficient manner that eliminates duplication. Filtering would effectively eliminate part of the registry requiring those using the registry to duplicate work already performed. This is in direct contrast to the goals and aims of Leung. Therefore, there is no motivation or suggestion to combine Leung with any filtering aspects because the resulting invention is contrary to Leung. Applicant, therefore, requests withdrawal of the rejection.

In light of the above discussion, Applicant believes Examiner is using hindsight to combine the Leung reference with the alleged obviousness to one skilled in the art. There is no motivation or suggestion to combine and there is no likelihood of success in combining. Therefore, Applicant believes withdrawal of the 35 U.S.C. § 103(a) rejections of claims 1-32 is necessary.

Conclusion

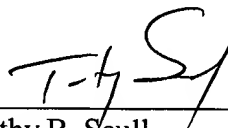
As originally filed, the present application included 32 claims, 3 of which were independent. Applicant believes this Amendment responds to each and every issue raised by the Examiner. No claims have been added (or amended into independent form). A Petition for a Two-Month Extension of Time is submitted herewith, along with our check in the amount of \$420.00. It is believed that no further fees are due with this Response. However, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment with respect to this patent application to deposit account number 13-2725.

Application No. 09/360,440

In light of the above remarks and amendments, it is believed that the application is now in condition for allowance, and such action is respectfully requested. Should any additional issued need to be resolved, the Examiner is requested to telephone the undersigned to attempt to resolve those issues.

Date: 6/14/04

Respectfully submitted,



Timothy B. Scull
Reg. No. 42,137
Merchant & Gould P.C.
3200 IDS Center
80 South Eighth Street
Minneapolis, MN 55402-2215
(303) 357-1648